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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,555	11/20/2001	M. David Boothe	BOO001/0135818	1685
7590	05/20/2004		EXAMINER	
GARY L. BUSH ANDREWS & KURTH MAYOR, DAY, CALDWELL & KEETON L.L.P. 700 LOUISIAN, SUITE 1900 HOUSTON, TX 77002			LUGO, CARLOS	
			ART UNIT	PAPER NUMBER
			3676	
DATE MAILED: 05/20/2004				

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 14

Application Number: 09/989,555

**MAILED**

Filing Date: November 20, 2001

MAY 20 2004

Appellant(s): BOOTHE, M. DAVID

**GROUP 3600**

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Brett Cooke  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed on March 8, 2004.

**(1) Real Party in Interest**

A statement identifying the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is correct.

**(7) Grouping of Claims**

Claims 9-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. In particular, while claim 11 was stated to stand or fall apart from claims 9 and 10, claim 11 has not been separately argued. Accordingly, claim 11 stands or fall with claims 9 and 10. See 37 CFR 1.192(c)(7).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

3,078,917	Recchione	2-1963
4,930,563	Finch et al.	6-1990
357,116	Coultaus	2-1887
426,389	Lacey	4-1890
6,076,867	Dollman et al.	6-2000

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

- Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recchione (US 3,078,917) in view of either Lacey (US 426,389), Dollman (US 6,076,867) or Coultaus (US 357,116).
- Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finch (US 4,930,563) in view of either Lacey (US 426,389), Dollman (US 6,076,867) or Coultaus (US 357,116).

Recchione discloses a roll up door (22) having a springless latch mechanism (Figure 2). The latch mechanism includes a latch plate (115) and a latch (118 and 119) mounted on the latch plate. The latch is arranged for horizontal movement between an open and a closed position by moving a locking piece (119) into and out of engagement with a slot (124) of the wall.

Finch discloses a roll up door (120) having a springless latch mechanism (130,132,134 and 136). The latch mechanism includes a latch plate (130) and a latch (132 and 134) mounted on the latch plate. The latch is arranged for horizontal movement between an open and a closed position by moving a locking piece (134) into and out of engagement with a slot (136) of the wall.

Lacey teaches that is known in the art to have a sliding latch (A) with a hole and a loop directly connected to the loop (Figures 1 and 2).

Dollman teaches that is known in the art to have a sliding latch (11) with a hole (30) and a loop (29) directly connected to the loop.

Coultaus teaches that is known in the art to have a sliding latch (A) with a hole and a loop (where pin d is located, Figures 2 and 3).

#### **(11) Response to Argument**

With respect to appellant's arguments beginning on page 4 of the brief, it should be noted that the proper test for obviousness under section 103 is what the combination of reference teachings, taken collectively, would have fairly suggested to one ordinary skill in the art and motivation for combining the teachings of the various references need not be explicitly found in the references themselves, for example see *In re Keller*, 642 F. 2d 413, 208 USPQ 871 (CCPA 1981).

Indeed, in the instant case, Recchione and Finch, each respectively, disclose a springless sliding latching mechanism. Lacey, Dollman and Coultaus each teach the use of a loop attached to a sliding latch mechanism to assist in the operation of the latch mechanism.

Appellant's arguments with respect to the teachings of Lacey, Dollman and Coultaus are based on the premise that the latch mechanism has a spring to move the latch into the closed position from the open position and that the loop only is used to facilitate movement of the latch from the closed position to the open position.

Be this as it may, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art. See MPEP 2145 and *In re Keller*, supra.

Further, it is not necessary that the inventions of the references be physically combinable in order to render obvious the invention under review. See *In re Sneed*, 710 F.2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983).

In the instant case, Recchione and Finch each includes a roll-up door and a springless latching mechanism that moves from an open to a closed position and vice versa by simply moving a locking piece into and out of engagement with a slot of the wall. Lacey, Dollman and Coultaus each teach the provision of a loop to a latch mechanism to assist in the operation of the particular latch mechanism. Accordingly, the provision of either Recchione or Finch with a loop as taught by any one of Lacey Dollman or Coultaus would result in a springless latching mechanism having a loop. Thus, the resultant structure would "read on" the appellant's structure of claim 9. Moreover, while the loop is taught to be utilized to move the latch to the

open position, it is quite evident that the loop is also inherently capable of being utilized to move the latch back to the closed position.

Therefore, the principle of operation of the primary reference (Recchione and Finch) does not change.

The examiner further wishes to point out that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, supra; *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to appellant's arguments that the prior art does not suggest the desirability of using a loop to help a user close a latch, nor does the prior art suggest the desirability of using a loop to help a user with a prosthetic limb to operate the latch (Page 7 Line 21), it should be noted that patentability of a product claim is based on the structure recited therein, not how such structure is intended to be used or who is to use the structure. The Prior Art provides clear teaching to provide a loop to the latching mechanism and any such loop provided is clearly capable of not only moving the latch to an open position, but also to moving a latch from an open to a closed position. Moreover, a combination is proper for any reason known in the art and Lacey, Dollman and Coultaus provide clean teaching to provide Recchione or Finch a loop to assist in moving the latch from the closed position to an open position.

As to appellant's arguments that the combined teachings of the prior art taken as a whole actually teach away from the invention and destroy the intended function of

the invention (Page 8 Line 1), the principle of operation of the primary reference, Recchione or Finch, does not change with the incorporation of the loop described by Lacey, Dollman or Coultaus.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Carlos Lugo *cc*  
May 14, 2004

Conferees  
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